



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1460
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 10/675,235 | 09/30/2003 | Jeffrey Raymond Reihl | 5247/14P | 9832 |
| 29858 | 7590 | 05/18/2006 | EXAMINER | |
| BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP | | | ONI, OLUBUSOLA | |
| 900 THIRD AVENUE | | | ART UNIT | |
| NEW YORK, NY 10022 | | | PAPER NUMBER | |

2168

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/675,235 | Applicant(s) REIHL ET AL. | |
| | Examiner OLUBUSOLA ONI | Art Unit 2168 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 Feburary 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 21-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed February 28, 2006 has been entered. Claims 20-25 are new

Applicant has to provide an application number for one of the related applications in the specification.

Election/Restrictions

2. Newly submitted claims 21-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 1 is directed toward an internet delivery method delivery electronic information products While claims 21-25 introduces a healthcare information system.

Since applicant has received an action on the merits for the originally presented Invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 9-16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Deepak Puri, Mississauga (Pub No. US 2001/0037241). (hereinafter Puri).

For claim 1, Puri teaches:

"An Internet delivery method delivering electronic information products to a plurality of Users via the Internet, the method" (see e.g., [0037]) "comprising:
storing a plurality of display formats in a database, said display formats including at least a default display format and a custom display format; for each one of said plurality of users, storing information indicating whether the user is a specific type of user;" ([0039-0041], [0045-0057] and [0114] wherein Puri's teachings include verifying user type. Puri's teaching also includes a user (customizing) or relies on series of incentive program templates (default), however selection will be saved in database 110.

Puri teachings also include customized applications updating or notifying registered users of any changes, thus teaching are synonymous)

"when a user logs in, identifying whether or not the user is said specific type of user; and if said user is identified as said specific type of user, then delivering an electronic Information product to said user in said custom display format" ([0039-0041] and [0114] which describes a customized display format due to login verification and delivering updates or notifying registered users of any changes to users user interface, thus teaching are synonymous)

For claim 2, "subscription account information" ([0039 and 0072], after registration 108,the user is asked to enter varied information).

For claim 3, " wherein there are a plurality of user types and a respectively corresponding plurality of custom display formats" ([0041] different users get different customized display format based on their needs or the user type).

For claim 4, "custom display formats in different languages" ([0110]).

For claim 5, "either custom display formats and default display format includes flexible or changeable information"([0114] talks about notifying registered users of any changes).

Art Unit: 2168

For claims 6, "electronic information product is transmitted to a wireless device" ([0106] note that PDAs are included in the paragraph as a way of receiving information in a wireless environment).

For claim 9, "the user's use of the method is tracked" ([0111] tracking is included in the paragraph as the method of tracking usage).

For claims 10, Puri teaches:

"An Internet delivery system adapted to deliver electronic information products to a Plurality of users via the Internet, the system" ([0037]) "comprising: at least one computer having: one or more content databases storing data or other information for electronic information products" ([0039-0040] and note database 110 confirms the users data stored on the database, after verification, control panel 6 will be accessed).

"one or more modules; and a network connecting said at least one computer to a plurality of users via the Internet"([0034] note that the internet and computers are included in the paragraph as a medium through which users interact and transact).

"wherein the one or more modules are capable of: identifying whether or not a use is a specific type of user and, if the user is said specific type of user, then delivering an electronic information product to said user from said one or more content databases in a custom display format" ([0037],[0039 -0041], [0114] wherein Puri teaches registration process 108 through which needs of each user will be determined

Art Unit: 2168

thereby customized content may be sent to such users(type of information display) like wise Puri's teachings also include customized applications updating or notifying registered users of any changes which is been delivered to the users user interface , thus teaches are synonymous)

As per claim 11, "subscription accounts information" (this claim is rejected on the grounds corresponding to the arguments given above for rejecting claim 2).

As per claim 12, " wherein there are a plurality of user types and a respectively corresponding plurality of custom display formats" (this claim is rejected on the grounds corresponding to the arguments given above for rejecting claim 3).

As per claims 13,"custom display formats in different languages" (this claim is rejected on the grounds corresponding to the arguments given above for rejecting claim 4).

For claims 14, "either custom display formats and default display format includes flexible or changeable information" this claim is rejected on the grounds corresponding to the arguments given above for rejecting claim 5).

For claims 15, "transmitted electronic information product to a wireless receiving device" (this claim is rejected on the grounds corresponding to the arguments given above for rejecting claim 6).

For claims 16, "electronic information product is transmitted wirelessly" ([0106] note that PDAs are included in the paragraph as a way of receiving information in a wireless environment, Fig 1 of Puri's drawings also shows the Internet transmitting information to a PDA in a wireless fashion, which is similar to the applicants claim language).

For claim 19, "the user's use of the method is tracked" (this claim is rejected on the grounds corresponding to the arguments given above for rejecting claim 9).

As per claim 20, this claim is rejected on the grounds corresponding to the arguments given above for rejecting claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puri as applied to claims 6 above, and further in view of David Chou (Pub No. US 2003/0004984).
(hereinafter David).

As per claim 7, this claim is rejected on the grounds corresponding to the arguments given above for rejecting claims 6 above including the following reasons: Puri does not explicitly teach "the electronic information product is transmitted in a customized display format appropriate for the wireless device". David teaches

"the electronic information product is transmitted in a customized display format appropriate for the wireless device" (see paragraph [0020]). It would have been obvious for one skill in the art at the time the invention was made to have combined the teachings of Puri and David, because using the steps of "the electronic information product is transmitted in a customized display format appropriate for the wireless device" would have given those skilled in the art the tools to display data, in a customized fashion. Automatically selecting and outputting of the specification according to the mobile phone or PDA to achieve the best visual effect can be an advantage to the user.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Puri as applied to claims 15 above, and further in view of Rahn et al. (Pub No. US 2002/0103008).
(hereinafter Rahn).

Art Unit: 2168

As per claim 17, this claim is rejected on the grounds corresponding to the arguments given above for rejecting claims 15 above including the following reasons: Puri does not explicitly teach "electronic information products transmitted by cradle synchronization" Rahn teaches "electronic information products transmitted by cradle synchronization"(see paragraph [0046]). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Puri and Rahn, because using "electronic information products transmitted by cradle synchronization" would have given those skilled in the art tools to receive information using cradle. This gives the users the advantage of communicating through his PDA using the cradle even though he is away from his desktop.

7. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri as applied to claims 1 and 10 above, further in view of Patel et al. (Pub No. US 6411836) (hereinafter Patel).

As per claim 8 and 18, Puri does not explicitly teach "healthcare information". Patel teaches "healthcare information" (col.3, lines39-45). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Puri and Patel, because using "healthcare information" would have given those skilled in the art tools to provide patient information in various display formats. This gives users the advantage of retrieving patient information.

Response to Amendment

8. Applicant's arguments filed February 28, 2006 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's argument. Applicants argued that Puri does not teach: "storing plurality of display formats". On the contrary, wherein on ([0040-0041], [0045-0057] and [0114] Puri's teaches an authorized user can either creating (customizing) or rely on series of incentive program templates (default), however selection will be saved in database 110. Puri teachings also include customized applications providing updates or notifying registered users of any changes, which reads on applicants claim language)

In response to applicant's argument that the reference fails to show certain feature of applicant's invention. It is noted that the features upon which applicant relies ("Multiple display formats") are not recited in the rejected claim(s). Although the claim is interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's argued that "delivery of an electronic information product in a customized display format". On the contrary, at ([0037], [0039 -0041] and [0114] Puri teaches registration process 108 through which needs of each user will be determined thereby customized content may be sent to such users (type of information display) like wise Puri's teachings also include customized applications updating or notifying registered users of any changes which is been delivered to the users user interface, thus teaches are synonymous).

Regarding the David reference applicant's argued that David does not teach "customized display format of an electronic information product".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case Puri teaches transmitting electronic information product in a customized display format ([0037], [0039-0041], [0106] and [0114], but does not explicitly teach "the electronic information product is transmitted in a customized display format appropriate for the wireless device" as claimed. However, David teaches a device specification database 15 for storing the specifications (such as the size of screen, the number of pixels, the number of characters which can be display in a row, the color of screen or font of character) of the mobile phone 10 or PDA 12 [0020]. Thus, it would have been obvious for one skill in the art at the time the invention was made to have combined the teachings of Puri and David, because using the steps of "the electronic information product is transmitted in a customized display format appropriate for the wireless device" would have given those skilled in the art the tools to display data, in a customized fashion. Automatically selecting and outputting of the specification according to the mobile phone or PDA to achieve the best visual effect can be an advantage to the user.

Regarding the Rahn reference applicant's argued that Rahn does not teach "customized display format of an electronic information product".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case Puri teaches transmitting electronic information product in a customized display format ([0037], [0039-0041], [0106] and [0114], but does not explicitly teach "the electric information product is transmitted by cradle synchronization" as claimed. However, Rahn teaches the electric information product is transmitted by cradle synchronization, at paragraph [0041-0046]. Thus, It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Puri and Rahn, because using "electronic information products transmitted by cradle synchronization" would have given those skilled in the art tools to receive information using cradle. This gives the users the advantage of communicating through his PDA using the cradle even though he is away from his desktop.

Regarding the Patel reference applicant's argued that Patel does not teach "customized display format of an electronic information product".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871

(CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case Puri teaches transmitting electronic information product in a customized display format ([0037], [0039-0041], [0106] and [0114], but does not explicitly teach "the electric information products comprises healthcare information" as claimed. However, Patel teaches the electric information products comprise healthcare information at (Col. 3, lines 39-45). Thus, It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Puri and Patel, because using "healthcare information" would have given those skilled in the art tools to provide patient information in various display formats. This gives users the advantage of retrieving patient information.

In light of the foregoing arguments, the 35 U.S.C. 102 and 103 rejections are hereby sustained.

Conclusion

9. The following prior art cited on the PTO-892 form, not relied upon, is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUBUSOLA ONI whose telephone number is 571-272-2738. The examiner can normally be reached on 7.30-5.00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OLUBUSOLA ONI

Examiner Art Unit

2164


TIM VO
PRIMARY EXAMINER